

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re US Patent No.: 7,622,480)	
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Silvia FONQUERNA POU, et al.)	Group Art Unit: 1625
)	
Application No.: 10/509,279)	Examiner: David E. Gallis
)	
§ 371 date: May 5, 2005)	Confirmation No.: 1079
)	
For: AZAINDOLYLPIPERIDINE DERIVATIVES)	VIA EFS-WEB
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Sir:

APPLICATION FOR PATENT TERM ADJUSTMENT-POST GRANT

In accordance with 37 C.F.R. § 1.705(d), Applicants hereby apply for patent term adjustment under 35 U.S.C. § 154(b) of 1,356 days. This Application is being timely filed within two months of issuance of the patent and is based on the recent Federal Circuit decision in *Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir. January 7, 2010).

I. Statement of the Facts Involved

A. Correct Patent Term Adjustment

U.S. Patent No. 7,622,480 B2 currently indicates a patent term adjustment ("PTA") of 573 days on its cover. However, Applicants have calculated a patent term adjustment of 1,356 days based on the following facts:

The above-identified application claims priority from Spanish Application No. ES 200200753, filed on April 1, 2002. The commencement date for this application is the day after the expiration of the 30 months from the earliest priority date, which is October 2, 2004. This application was filed on September 28, 2004, and met all the requirements under 35 U.S.C. § 371 on May 5, 2005.

The first Office Action, a Restriction Requirement, was mailed on March 12, 2008, creating a U.S. Patent and Trademark Office (USPTO) delay of 616 days beyond the 14 months provided by 35 U.S.C. § 154(b)(1)(A)(i).

Applicants filed a response to the Restriction Requirement on April 14, 2008. A non-final Office Action was mailed on July 3, 2008, and Applicants filed a response to that Office Action on October 3, 2008.

The USPTO mailed a final Office Action on February 4, 2009, incurring a delay of 1 day beyond the 4 months provided by 35 U.S.C. § 154(b)(1)(A)(ii). On June 17, 2009, Applicants filed a response to the Final Office Action, incurring in a delay of 44 days.

On July 23, 2009, a Notice of Allowance was mailed.

On October 15, 2009, Applicants paid the Issue Fee.

On November 24, 2009, the patent issued.

Under *Wyeth v. Kappos*, the period of patent term extension under 35 U.S.C. § 154(b)(1)(B) ("3-year pendency rule") begins to toll three years after filing the application, or in the case of §371 application, three-years after on the commencement date of the application. Thus, the period of patent term extension under 35 U.S.C. § 154(b)(1)(B) began on October 2, 2004, and ended with the issuance of the patent on November 24, 2009. The USPTO delay during that time period

amounts to 784 days, (i.e., the number of days between October 2, 2004, and November 24, 2009). See 37 C.F.R. § 1.703(b)(4).

Wyeth v. Kappos instructs that the USPTO delay of 784 days under the 3-year pendency rule provided by 35 U.S.C. § 154(b)(1)(B)) should be counted in addition to the 616 day USPTO delay under the 14 month delay provided by 35 U.S.C. § 154(b)(1)(A) that occurred during prosecution of the application because the periods of time corresponding to these two types of delay did not overlap in time (i.e. they did not occur on the same calendar day). The 1 day delay that occurred as a result of issuing an Office Action on February 4, 2009, overlaps with the 784 days mentioned above, and, therefore, this one day of delay is not counted towards the total USPTO delay of 1440 days (i.e., 784 days plus 616 days).

Applicants' delay of 44 days should be subtracted to the total USPTO delay of 1440. Thus, the total PTA available for the instant patent is 1,356 days ($1440 - 44 = 1,356$). Applicants respectfully request that the current patent term adjustment be reconsidered.

B. Terminal Disclaimer

The above-identified application is not subject to a Terminal Disclaimer.

C. Reasonable Efforts

To the best of the undersigned's knowledge, aside from the facts mentioned above, there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing of examination of the above-identified application as set forth in 37 C.F.R. § 1.704.

II. Fee

As required by 37 C.F.R. § 1.705(b)(1), this Application is accompanied by the required fee of \$200.00. Please charge any deficiencies to Deposit Account No. 06-0916. If there are any other fees due in connection with the filing of this Application, please charge such fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: January 22, 2010

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